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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent Application of : Group Art Unit: 2155
Christopher J. Halliday :
Appn. No.: 09/922,487 : Examiner: Kevin Bates
Filed: August 3, 2001 :
For: Method and Apparatus for Selecting :
Satellite Audio Radio Channels :
:

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL REQUEST FOR RECONSIDERATION OF THE DECISION ON
APPEAL DATED DECEMBER 14, 2009

Appellant respectfully requests reconsideration of the Board of Patent Appeals and Interferences Decision on Appeal dated December 14, 2009, under 37 CFR 41.50(b)(2). Appellant believes the Board misapprehended or overlooked the following points in rendering its decision.

I. Appellant's Invention

Appellant invented a method and apparatus useful for alerting a user when a work of authorship that matches a designation of a work that is stored by a user in a memory is playing a satellite audio radio channel other than the current user's channel. Appellant's invention accomplishes this by using a single receiver, that is, a single receiver is used in the course of performance of at least the following: receive signals, save a designation, provide signals (e.g., audio) to a user and scan other satellite audio radio channels. Appellant's invention eliminates the need for an auxiliary receiver and forces the single receiver of the invention to perform additional functions. The claimed invention is electrically, mechanically and functionally different than the cited art.

II. The Board applied the wrong standard of review on Brief

In sustaining the Examiner's rejection, the Board concluded:

"Appellant has not shown that the Examiner erred in finding that the claimed single mobile receiver is obvious in view of Robbins' receiver system."^{1,2}

However, in a newly issued precedential opinion, the Board has ruled that examiner findings are to be given no deference when challenged on appeal. In the precedential case *Ex Parte Frye* (BPAI 2010), the Board held:

"[T]he Board reviews the particular finding(s) contested by an Appellant anew in light of all the evidence and argument on that issue".

Accordingly, the decision that is currently the subject of Appellant's (1) Request for Reconsideration filed on January 29, 2010; and, (2) the present Supplemental Request for Reconsideration, clearly rests on an improper standard of review because the Board gave significant deference to the examiner and because the Board did not review the claims anew in light of all of the evidence and arguments submitted by Appellant.

In the present case the Examiner and the Board ascribe an unreasonably broad meaning to the critical claim limitation "single receiver." Accordingly, for all the reasons stated in the Appeal Brief, Reply Brief and the subsequent Requests for Reconsideration, the holding should be reversed in light of all the arguments and evidence presented.

III. The Board misapprehended Appellant's arguments on Brief

In sustaining the Examiner's rejection, the Board misapprehended portions of Appellant's argument, which had a subsequent bearing on the Board's decision.

"Appellant argues that none of the references employs the same receiver to save a designation of work of authorship while scanning for selections in real time (App. Br. 20). Further, Appellant argues that none of the references employs the same receiver to scan for selections in real time while providing the user audio and notification alerts. *Id.* See also Reply Br. 4" This characterization is correct.

¹ Throughout this paper, excerpts from the Board's decision and the prior art are set out in "Bold small type face"
² Decision on Appeal, Page 13

"In fact, Appellant argues that the claimed invention accomplishes with one satellite audio receiver that which previously would have required two or more receivers (App. Br. 22)" This characterization is correct.

"Appellant's assertion that Robbins teaches away from the use of multiple receivers is based upon Robbins' disclosure of reducing the number of auxiliary receivers while maintaining that auxiliary receivers are still required (App. Br. 27)" The Board misapprehended this argument.³ Appellant argued Robbins always requires a main receiver and at least one auxiliary receiver together in a system to function as intended, and thus teaches away from the claimed invention. Even though Robbins discloses reducing the number of receivers as a cost saving option, Robbins requires a main receiver and at least one auxiliary receiver. Thus, Robbins always contemplates the presence of at least two receivers. In other words, under the teaching of Robbins, the total number of receivers cannot be reduced to less than two and therefore Robbins does not contemplate or suggest the single receiver of the claims. As explained further below, even if the main and auxiliary receivers are integrated as asserted by the Board, such integration does not result in the claimed single satellite audio radio receiver (hereafter "single receiver") invention.

IV. The Board's conclusions are based on the application of the wrong law to a misunderstanding of the factual underpinnings of the present case

The Board's decision rests solely on the premise that if the main and auxiliary receivers of Robbins are mechanically integrated, under *In re Larson*⁴, one of skill in the art would arrive at the claimed invention. The Board does not supply any rationale for how the claims are an integration, or how one would integrate the receivers of Robbins or what would actually result from such an integration other than to remark that it is an "obvious expedient" to integrate the receivers and thereby arrive at the claimed invention.

³ Appellant argued that

At the time of the invention, to one of ordinary skill in the art, Robbins teaches away from eliminating all auxiliary receivers or considering an auxiliary receiver alone in a vacuum or even considering the consolidation of a main receiver and auxiliary receiver(s) together into one receiver because (1) the use of a plurality of auxiliary receivers is explicitly stated as providing superior results relative to a single auxiliary receiver (even in the relatively simple embodiment of Robbins) and because multiple stream types can be scanned using auxiliary receivers, (2) Robbins requires at least one auxiliary receiver in combination with a main receiver to function, and (3) Robbins does not disclose or suggest that the objectives of the invention can be met, even in an inferior manner, in the absence of either a main or auxiliary receiver.

⁴ *In re Larson* 340 F.2d 965

⁵ Decision on Appeal, Page 9

While Appellant concedes that in certain instances, legal precedent can provide the rationale supporting obviousness if the facts in the case are sufficiently similar to those in the application,⁶ Here, the facts in *In re Larson* are sufficiently dissimilar to those in an application under examination, and thus neither the examiner nor the Board may use the rationale used by the court. Specifically, for all the reason in the Appeal Brief and Reply Brief and as further explained below, Appellant has demonstrated the criticality of the "single receiver" limitation, and therefore Appellant has demonstrated that it is inappropriate to rely solely on the rationale used by the court as the Board had done here to support an obviousness rejection.⁷

In particular, *In re Larson* is distinguishable from the facts of the present case, and while a summary of *In re Larson* is detailed in the MPEP⁸, a short summary follows to illustrate the Board's reasoning. In *In re Larson*, the prior art showed a brake disc and clamp baseless position in light of the case cited. In *In re Larson*, the prior art showed a brake disc and clamp comprising several parts rigidly secured together as a single unit whereas the claimed invention recited the term "integral" in claim 12, where a brake drum was integral with the clamping means. The CCPA affirmed the rejection in *In re Larson* holding "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be a matter of obvious engineering choice". The CCPA also noted that the claims defined no structure which would afford an unobvious distinction over the applied reference.

Here, the Board overlooks (A) the important facts underpinning the holding in *In re Larson*. Specifically, the brake and clamp were present in each of the claimed invention and the prior art, and (B) the claims at issue here explicitly recite the structure that distinguishes the claimed invention from the applied Robbins reference, alone or in combination with the other cited art; and, (C) the properly applied case law further supports Appellants position that the claims provide unrebutted indicia of unobviousness.

A. The Board's decision ignores the meaning of the term "integral"

In its ruling in *In re Larson*, the CCPA turned to Webster's New International Dictionary (Second Edition) to define the term integral as '(2) Composed of constituent parts making a whole; composite; integrated.' Using this definition, the CCPA stated that the invention merely connected through one piece construction that which was already described as joined together in a unitary whole. In that case, the brake and clamp were present in both the claimed invention and the prior art.

⁶ See, e.g., MPEP 2144

⁷ Id.

⁸ MPEP 2144.04 (V) (B)

With respect to the set of facts currently before the Board, *In re Larsen* is wrongly applied because the claimed invention accomplishes with a single satellite audio receiver that which previously would have required two or more receivers operating together.

While the Board points to the main and auxiliary receivers of Robbins as support for its position, the Board fails to recognize that even if "integrated", under the doctrine set forth in *In re Larson* the device resultant from the hypothetical integration would, as a matter of law, result in something other than the claimed single receiver of the present inventive method and apparatus.

Quite simply, under its analysis, the Board is applying the holding of *In re Larsen* without regards to the actual claim limitations, and by virtue of this misapplication of the law, the Board is improperly comparing the system of a plurality of receivers of the cited art with the single receiver of the claimed invention. How can two or more receivers (integrated or otherwise) working together, but having explicitly different functions, be considered a single receiver? Again, the Board's construction of the term "single receiver" is unreasonable and defies common sense.

Just as the Board held in *Ex Parte Frye*, where the examiner's decision was reversed because the examiner interpreted the claim terms inconsistent with the specification and ordinary and customary meaning of the term at issue,⁹ here Appellant has clearly shown that the interpretation of the claimed "single receiver" is also unreasonably broad. For the Board's analysis to be correct, the claimed single receiver must mean "a main and an auxiliary receiver together in a system." Such an interpretation is contrary to the law of *In re Larson*, contrary to the facts of the present case, contrary to Robbins itself (see e.g., Fig 8(a) and other teachings of Robbins which indicate that an auxiliary receiver is always needed), contrary to the other cited references; contrary to arguments made by Appellant, as well as contrary to the meaning and context of the terms as used by Appellant and as such terms would be understood by one of ordinary skill in the art, as further discussed in part B, below.

(B) The claims recite structure which provides unrefuted indicia of unobviousness.

The Board indicates: "while it is clear that Robbins employs multiple receivers to form one homogenous receiver system, the internal components of Appellant's receiver have not been disclosed. Appellant does not provide any support for his position that the claimed receiver differs from the receiver system employed by Robbins."¹⁰

Here, the Board concedes that Robbins employs multiple receivers. In light of Appellant's explicit claim limitations directed to a single receiver, this admission alone is sufficient to show that both

⁹ *Ex Parte Frye*, page 14

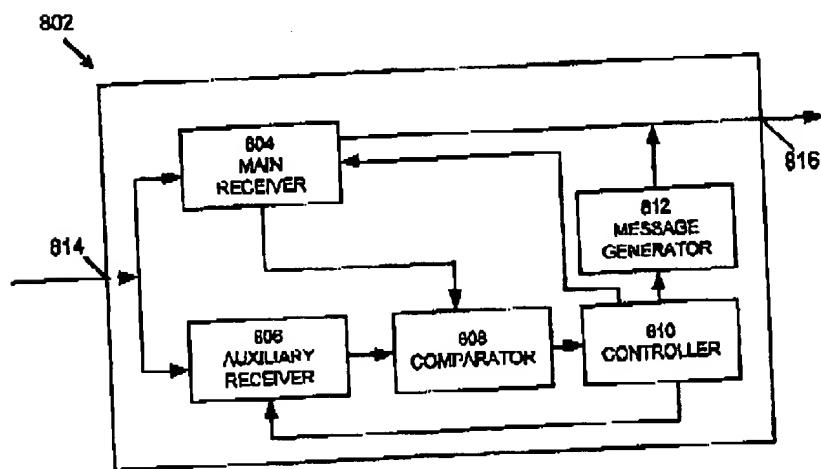
¹⁰ Decision on Appeal, page 8

the Examiner and the Board have erred in the respective analyses, in that the system of two or more receivers of Robbins, alone or in combination with the cited art, does not result in the claimed single receiver.

Appellant also respectfully submits that the system formed by Robbins is far from homogeneous, as asserted by the Board, because the system clearly includes at a minimum two different receivers having different functions (i.e., a main and an auxiliary receiver). Indeed, support for Appellant's position that the claimed receiver differs from the receiver system employed by Robbins is explicit in the claim limitations directed to a single receiver. For the reasons specified below, it defies logic and common sense to suggest that a single receiver is the same as a system of two or more receivers.

Robbins overall system is shown in Fig. 8(a), reproduced in the Board's decision and is also reproduced below:

FIG. 8(a)



Note that Robbins' system includes main receiver 804 and auxiliary receiver 806.

Compare the proceeding with a non-limiting schematic set forth in Appellants application, where reference number 320 is a single receiver, as set forth in Fig. 3:

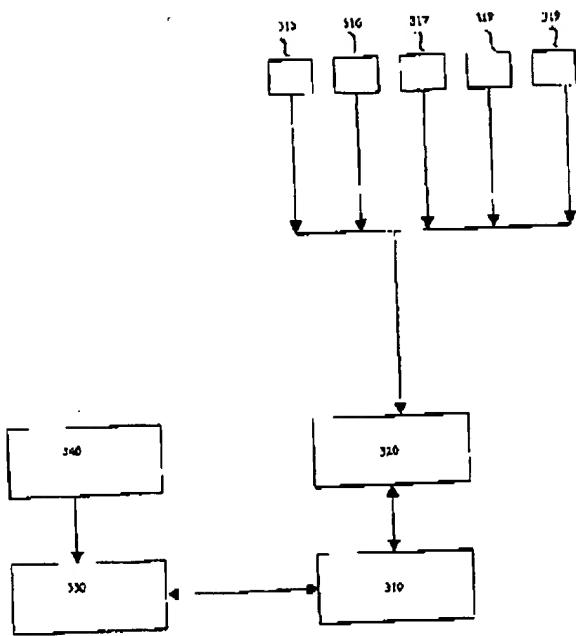


Figure 3

By comparing the claims in the context of the non-limiting illustration of a portion of Appellant's claimed invention to Robbins' system, it is clear that the single receiver, shown schematically as "the receiver 320," the claim language distinguishes the invention mechanically, electrically and functionally. The claimed invention is not and cannot be a main receiver and a separate scanning auxiliary receiver arranged in a system of two or more receivers. By the Board's own characterization of Robbins, the claimed invention is completely different than the cited reference or combination of references.

While it is unclear why the Board indicates that the internal components of Appellant's receiver (circuits etc.) need to be disclosed,¹¹ contrary to the statements made by both the Board and the Examiner, additional non-limiting internal components of a single receiver within the scope of the claims is explicitly disclosed in the as-filed application.¹²

¹¹ Decision on Appeal, page 8, last paragraph
¹² e.g., non-limiting prophetic Example 3.

Additionally, the specification as filed is replete with reasonable support for the claimed and distinct structure of a "single receiver," including at least single reference number 320 in Fig. 3 and reference to "a receiver" and "the receiver 320" in the specification, as explained in the Appeal Brief.¹³ Contrary to the Board, it is at least the explicitly claimed "single receiver" limitation that distinguishes the invention from the receiver system employed by Robbins.

C. *In re Edge*¹⁴ supports the patentability of the claims

Appellant respectfully submits that in light of the facts of this case, the Board's decision ignores the correct law. Here, the Board has not addressed Appellant's arguments supported by *In re Edge* and clarification is respectfully requested.

Appellant has argued that under the rules set forth in the MPEP at § 2144.04(II)(B), which section more completely summarizes the holding of *In re Edge*, the claimed invention provides unrefuted indicia of unobvious because, generally, Robbins' required feature of one or more auxiliary receivers that scan for ID codes is omitted, while Appellant's invention retains the omitted features function. Specifically, by reciting a single receiver, the claimed invention explicitly omits, at least, the auxiliary receiver yet retains the desired scanning function of the omitted element. Moreover, the Board's decision renders *In re Edge* meaningless because arguably any removal of a feature could be then considered "an integration."

Here, once the correct law is applied the facts show that Robbins actually teaches away from the claimed invention because Robbins explicitly teaches that the number of auxiliary receivers can be decreased, but that an auxiliary receiver is still *required*.¹⁵ Robbins states in relevant part:

"The reduction in cost may be reflected in the decrease in the *needed* auxiliary receivers." (emphasis added)¹⁶

Even though the number of auxiliary receivers in Robbins may be decreased for the sake of cost at the expense of speed, there is a point at which the number of auxiliary receivers cannot be reduced any further because at least one auxiliary receiver is always needed for Robbins' invention to function.

This is because under Robbins, it is a fact that only an auxiliary receiver scans. In other words, at its most basic, Robbins requires at least two receivers (one main, one auxiliary) to function. Since an auxiliary receiver of Robbins is explicitly needed, if only a single auxiliary receiver is present in

¹³ Appeal Brief, page 16

¹⁴ *In re Edge*, 359 F.2d 896, 149 U.S.P.Q. 556 (CCPA 1966). Omission of an element and retention of its function is indicia of unobviousness.

¹⁵ U.S. Patent No. 6,317,882, col. 35, lines 49-54

¹⁶ Also cited in Appellant's Appeal Brief, page 27, underlined paragraph, Reply Brief, page 5, third full paragraph

combination with a main receiver, then it cannot be optional or removed without destroying the intended function of the Robbins reference.

In its decision, the Board misapplied the law to create the sole foundation for its conclusion, but failed to explain how the integrated device of Robbins, in combination with any of the other cited art, actually arrives at the claimed invention. Moreover, the Board provides no other rationale based on facts to support ignoring the required plurality of receivers of the cited art. Appellant knows of no better evidence of non-obviousness than proceeding in a direction contrary to the teachings of the reference. Here, Appellant's single receiver is neither main nor auxiliary to any other receiver, as explained in the Reply Brief¹⁷ and is therefore patentably distinct over the art.

Because the Robbins art perceives a need for auxiliary receivers (hence the "needed auxiliary receivers" statement in Robbins),¹⁸ Appellant's single receiver method and apparatus that accomplishes all of the functions of the main and auxiliary receiver system of Robbins, shows insight contrary to the expectations and understanding of the art which again is unrefuted indicia of patentability.

V. The combination of references should produce the claimed invention

The Board, in its own precedents, has held that "...the references must either expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why one skilled in the art would have found the claimed invention obvious in light of the teachings of the references." *Ex Parte Clapp*, 227 U.S.P.Q.2d 972, 973 (Board. Pat. App. & Inf. 985). Fundamentally, therefore, according to the Board's own precedents the combination of references and reasons must produce at least something akin to the claimed invention.

In view of this authority and others from the Federal Circuit, it is clear that the Board's reasoning and alleged combination of references must produce the claimed invention. In the present case, the Board has failed to meet this burden, because by its own reasoning it has shown that something else, and not the claimed invention, could be obvious over the alleged combination of references. Appellant contends that one of ordinary skill in the art, applying Tittlebaum and Owens to the primary Robbins reference in the manner applied by the Board, may have developed something, but not the single receiver invention of the claim. Therefore, the Board's reasoning cannot be considered convincing.

KSR does not change this conclusion. Under KSR common sense still prevails. In Appellant's view KSR does not change the standard that the showing must be of the actual claimed invention. KSR may have changed what constitutes suggestion or motivation to combine, but post-KSR, the claimed

¹⁷ Reply Brief, Page 6, last paragraph
¹⁸ U.S. Patent No. 6,317,882, col. 35, lines 49-54

invention, and not something else, still must be rendered obvious. Thus, under KSR common sense would dictate that to have proper motivation and a proper combination of references to teach the claimed invention, the reasoning and references must in fact produce the claimed invention and not something other than the claimed invention.

VI. The Board failed to consider separately argued dependent claim 77

The Board also failed to consider the fact that Appellant separately argued the patentability of claim 77 in both the Appeal Brief¹⁹ and Reply Brief.²⁰ As twice argued, Appellant respectfully submits that under the teachings of Robbins, if different signals for scanning are present (as claimed in claim 77), then the teachings of Robbins requires two or more auxiliary receivers for scanning - one for each of the different received signals.

Again, this is completely different from the claimed invention, which requires a single receiver in the course of scanning signals from different sources. Reconsideration of the patentability of the claim is respectfully requested.

VII. Conclusion

The Board's decision rests solely on a misapplication of the law to the facts and claim limitations under the incorrect standard of review. Even if the cited art is integrated as proposed by the Board, as a matter of law one of ordinary skill in the art would arrive at something other than the claimed invention. Here, the claims are directed to a single receiver apparatus and method, which is completely different than the cited art, alone or in combination. Moreover, the cited art teaches away from the claimed invention.

Reconsideration and reversal of the Board's December 14, 2009 decision is requested.

Alternatively, clarification of the basis of the Board's reasoning is requested in order for Appellant to prepare an appeal to the Federal Circuit.

Respectfully Submitted,

Date: 3/12/2010 By:



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¹⁹ Appeal Brief, page 26, second full paragraph

²⁰ Reply Brief, page 11, first two paragraphs, the entire Section B